

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Alexander Conrad, et al.

Serial No. 08/421,810

Group Art Unit: 2211

Filed: April 13, 1995

Examiner: E. Holloway III

Entitled: INTELLIGENT LOCATOR SYSTEM

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Pittsburgh, Pennsylvania 15219
June 4, 1997

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

LEAVE TO FILE AMENDED BRIEF PURSUANT TO 37 C.F.R. §1.192(d)

Sir:

An appeal brief for the Appellant in the above-identified patent application was received by the Patent and Trademark Office on January 16, 1997. In response, the Examiner issued an answer dated April 4, 1997. The answer included statements by the Examiner indicating a finding by the Examiner of non-compliance of Appellant's brief in regard to grouping of the claims, together with citations to 37 C.F.R. 1.162(c)(5). It is believed that the citation should have been made to 37 C.F.R. 1.192(c)(7). The Examiner states that claims will "stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof."

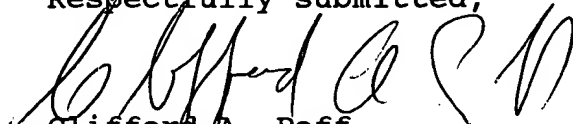
It is improper for the Examiner to make a finding of non-compliance in Appellant's brief and proceed directly to issue an answer. The Manual of Patent Examining Procedure states that the question of whether or not a brief is in compliance with the

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rules is a matter within the jurisdiction of the Examiner. See Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991); Section 1206. However, once that discretion has been exercised to find non-compliance, the rules specify steps which must be followed by the Examiner before an answer is properly issued. See Ex parte Schier, 21 USPQ2d 1016 (BPAI 1991); 37 C.F.R. 1.192(d). The rules state that where an Examiner has used his discretion to find non-compliance, "appellant *will* be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief." 37 C.F.R. 1.192(d) (emphasis added).

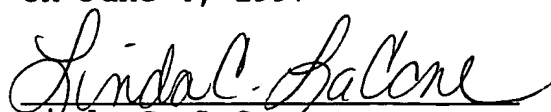
Accordingly, pursuant to 37 C.F.R. 1.192(d) Appellant requests that the Examiner issue a Notice of Non-compliance setting forth the reasons for the non-compliance and providing for a period of one month in which to file an amended brief.

Respectfully submitted,


Clifford A. Poff
Agent for Applicant

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on June 4, 1997


Linda C. LaCone
Date: June 4, 1997

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Pittsburgh, Pennsylvania 15219
June 4, 1997

Hon. Commissioner of Patents and Trademarks
Box Patent Appeals and Interferences
Washington, D.C. 20231

APPELLANT'S REPLY BRIEF

Sir:

The Appellant has concurrently herewith filed a Request for Leave to file an Amended Brief Pursuant to 37 C.F.R. §1.192(d). The Examiner's Answer does not respond to the grouping of claims to stand or fall together as requested in Appellant's Brief. In the event a substitute Examiner's Answer is filed in response to the anticipated Appellant's Amended Brief, it is requested that the Appellant be allowed to respond pursuant to 37 C.F.R. §1.193(b).

Appellant now responds without prejudice to the Examiner's Answer dated April 4, 1997. It is not Appellant's position that Mufti is non analogous because there are differences from Appellant's invention. It is the Appellant's position that Mufti does not disclose or suggest an algorithm for generating the unique binary identification code of that transmitter to control the burst transmission times to prevent synchronization with other transmitters. The Examiner's reliance on ID code 92 to prevent synchronization of interference is an incorrect factual

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determination of the disclosure by the reference. Not only is the code not used for the asserted purpose but in fact it has been pointed out in Appellant's Brief (page 14) that a counter is used. The argument in the Examiner's Answer that Mufti has provided the means responsive to an algorithm that also provides a binary code synchronization or interference is a hindsight reconstruction of Mufti using the teaching of Appellant's invention. No such disclosure or suggestion is found in Mufti. The argument commencing at the first complete paragraph of page 11 of the Examiner's Answer rationalizes a disclosure by Mufti fraught without support by Mufti and demonstrates the improper hindsight use of Appellant's invention.

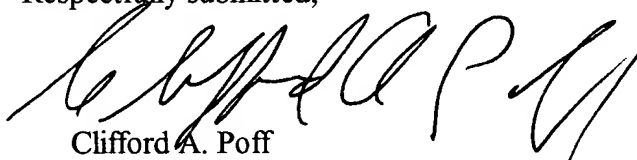
The Examiner relies upon a 1971 CCPA decision In Re McLaughlin 170 USPQ 209 on the issue of improper hindsight. Improper hindsight in obviousness determinations relates to the use of the teachings or suggestions of the present invention to fill in gaps left in the required teaching of the prior art in order to guide the selection of required elements from among various references. See *Para-Ordnance Manufacturing, Inc. v. SGS. Importers International, Inc.*, 37 USPQ2d 1237 (Fed. Cir. 1995); *In re Gorman*, 18 USPQ2d 1885 (Fed. Cir. 1991). "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. *Interconnect Planning*, 774 F.2d at 1143, 227 USPQ at 551. "The references themselves must provide some teaching whereby [Appellant's] combination would have been obvious."

In the paragraph commencing on page 13 of the Examiner's Answer, it is clear that the motivation to combine references comes from Appellant's disclosure not the references themselves. The arguments advanced recognize the failure of Guest (it is not practical to synchronize the multiplexing of transmitters to particular time slots for each transmitter) or where

there are too many transmitters to provide separate time slots for each (source of teaching unknown). To solve the problem the argument of the rejection contends "the technique of Haner minimizes the possibility that the signals will collide". Appellants respectfully submit that hindsight is clearly apparent.

For the above reasons its is believed that the rejections should be reversed.

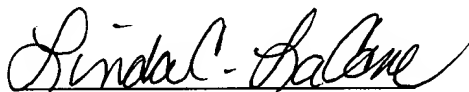
Respectfully submitted,



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Linda C. LaCone

June 4, 1997

Date